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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/621,032	07/21/2000	Leslie Gary Graf	27795-00018	4059

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EXAMINER

ORGAD, EDAN

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 03/31/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/621,032

Applicant(s)

GRAF ET AL.

Examiner

Edan Orgad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 July 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \*   c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 4-7, 10, 13-17, 19-26, 31 and 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Krishman (US Patent # 5,94,026).

Regarding claims 1 and 15, Krishman teaches a method of communicating in a telecommunication system including at least one mobile station, the method including the step of: providing operating capabilities of the mobile station at a node associated with the mobile station wherein the node is upstream in a communication path from the mobile station (col. 4, lines 7-10).

Regarding claims 2, 16 and 17, Krishman teaches the step of providing includes: transmitting a list of operating capabilities from the mobile station to the node via a message ad is a non call based measure (col. 4, lines 18-24).

Regarding claims 4 and 19-22, Krishman teaches the step of providing includes storing the operating capabilities at the node (col. 5, lines 30-39).

Regarding claim 5, Krishman teaches negotiating operating capabilities between the mobile station and a telecommunication element (col. 10, lines 11-27 & col. 16, lines 48-54).

Regarding claims 6 and 23-26, Krishman teaches comparing the operating capabilities stored at the node associated with the mobile station with operating capabilities stored at a node associated with the telecommunication element (col. 12, line 49- col. 13, line 27).

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Regarding claim 7, Krishman teaches selecting operating capabilities based on operating capabilities that are stored in common by both nodes (col. 16, lines 48-54).

Regarding claims 10, 31 and 32, Krishman teaches the telecommunication element is any one of a mobile station, a terminal device or a node (col. 15, lines 46-65).

Regarding claim 13, Krishman teaches negotiating operating capabilities between a mobile station in a mobile telecommunications network and a network node, wherein said mobile telecommunications network includes a storage means associated with a switching center serving said mobile station (col. 5, lines 30-39 & col. 10, lines 11-27); the method including the step of: transmitting a list of one or more operating capabilities from said mobile station to the switching center for storage in said storage means as part of a noncall based signal (col. 4, lines 18-24).

Regarding claim 14, Krishman teaches providing operating capabilities of a mobile station at a telecommunications network node to a telecommunications element during a call set-up procedure between the mobile station and said telecommunications element, and wherein said telecommunications element transmits to the telecommunications network node a list of operating capabilities of the telecommunications element as part of the call set-up procedure (col. 5, lines 30-39 & col. 10, lines 110-27), the method including the steps of: transmitting a list of operating capabilities of said mobile station from a switching center serving said mobile station to said telecommunication network node (col. 4, lines 18-24); providing said list of operating capabilities at said telecommunications network node; such that on initiation of a communication from said network element to said mobile station, said telecommunications network node internally selects one or more operating capabilities common to both the mobile station and the network element (col. 12, line 39- col. 13, line 27 & col. 16, lines 48-54).

*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 11, 12, 18 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishman (US Patent # 5,924,026).

Regarding claims 3 and 18 Krishman fails to specifically disclose the message is a location update message. However, official notice is taken that location update messages are very well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a location update message along with Krishman's existing message protocol in order to provide the switching center with further accuracy in case a handover was needed due to a weak signal of interference.

Regarding claims 11, 12 and 33-36, Krishman teaches a base station but fails to specifically disclose the node associated with the mobile station is any one of a MSC, a VLR, a HLR or a GMSC. However, official notice that it notoriously well known in the art to use MSC, VLR etc. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either MSC or VLR or HLR instead of the base station suggested by Krishman in order to reduce to strain or load of one switching center as oppose to another.

5. Claims 8, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishman (US Patent # 5,924,026) in view of Laiho (US Patent # 6,522,655).

Regarding claims 8, 27 and 28, Krishman fails to specifically disclose the operating capabilities include codecs. However, in the same field of endeavor, Laiho teaches operating

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capabilities including codecs (col. 6; line 56- col. 7 line 14). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include operating capabilities including codecs with Krishman's invention in order to better manage calls in the interintermediate nodes.

6. Claims 9, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krishman (US Patent # 5,924,026) in view of Cooper (US Patent # 6,321,079).

Regarding claim 9, 29 and 30, Krishman fails to specifically disclose the operating capabilities include security algorithms. However, in the same field of endeavor, Copper teaches operating capabilities including security algorithms (col. 3, lines 11-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include operating capabilities including security algorithms with Krishman's invention in order to make it difficult for unauthorized parties to make reverse network lock.

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### Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edan Orgad whose telephone number is 703-305-4223. The examiner can normally be reached on 7:30 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 703-305-4778. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-6306 for regular communications and 703-308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-7745.

Edan Orgad

*Edan Orgad*  
March 22, 2003

*Nguyen T. Vo*  
3/24/03

NGUYEN T. VO  
PRIMARY EXAMINER